

6296-0007-20 CONT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

H. BRITTON SANDERFORD ET AL. EXAMINER: Y. TSE

SERIAL NO: 08/859,378 DATE ALLOWED: FEBRUARY 2, 1999

FILED: MAY 20, 1997 GROUP ART UNIT: 2734

FOR: WIRELESS ALARM SYSTEM : BATCH NO. 061

STATEMENT OF RELEVANCY -
ADDITIONAL INFORMATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

U.S. Patent 5,598,427 ("427") issued January 28, 1997 from U.S. Application Serial No. 07/782,345, which is the parent application of the present application Serial No. 08/859,378, above-identified. The '427 patent issued upon granting of the Patentees' Petition under 37 C.F.R. §1.183 and 37 C.F.R. §1.137(b) to waive the one year filing period requirement in 37 C.F.R. §1.37(b) and to revive the previously abandoned parent U.S. Application Serial No. 07/782,345. The decision granting the petition was mailed February 9, 1996 over the signature of Robert W. Bahr, Senior Legal Advisor of the Special Program Law Office of the Office of the Deputy Assistant Commissioner for Patent Policy and Projects.

The present submission of additional information is made pursuant to telephone discussions between the undersigned attorney of record and Robert W. Bahr on January 26, 1999. Mr. Bahr then suggested filing the present papers as the best way to bring to the attention of the U.S. PTO additional information which became known to the undersigned

during litigation between prior attorney David Newman and the Assignee, Axonn, Inc., in regard to Mr. Newman's alleged malpractice leading to the abandonment for which revival was required. It was noted by Mr. Bahr that additional information to be submitted would be considered, and if warranted, the U.S. PTO may or may not require additional information and/or documentation and/or declarations further explaining the circumstances leading to the abandonment for which revival was obtained.

Accordingly, submitted herewith are the following Exhibits:

1. Declaration of David B. Newman dated October 2, 1997 further explaining the circumstances leading to the abandonment in light of additional information brought to Mr. Newman's attention during the litigation between himself and the Assignee, Axonn.

2. A copy of a Nov. 2, 1992 letter from Erin Pierce, Office Manager at Axonn to Anthony Natoli, associate in David B. Newman & Associates, referring to a conversation between David Newman and Steve Fant, Axonn's Vice President, and inquiring whether "unintentional abandonment ... is an option"

3. A copy of a Nov. 6, 1992 memo from Erin Pierce, to Britton Sanderford, the president of Axonn and a co-inventor in the subject application.

4. A copy of undated notes by Erin Pierce concerning discussions occurring some time in Jan. 1992 between Erin Pierce and David Newman.

5. A copy of a Jan. 21, 1993 letter from David Newman to Britton Sanderford including Sanderford's handwritten notes inquiring if David Newman can file "disgruntled employee paperwork."

6. A copy of a February 16, 1993 letter from Erin Pierce to David Newman, inquiring as to the status of three separate matters, including the subject Application Serial No.

07/782,345 and asking prior attorney David Newman "are we filing a disgruntled employee affidavit; do we need to let it go abandoned and then revive it?"

7. A copy of an internal memorandum dated February 17, 1993 from Erin Pierce to Britton Sanderford stating "... Dave [Newman] is waiting on Mike's [Michael Eckstein, outside counsel for Axonn] decision as to whether it would be more advantageous for us on the JA [James Arthur, a co-inventor] suit to let the patent [Serial No. 07/782,345] go unintentionally abandoned... ."

8. A copy of a Feb. 17, 1993 letter from Erin Pierce to David Newman asking David Newman to call Michael Eckstein.

9. A copy of a February 18, 1993 letter from Michael Eckstein to David Newman requesting that a telephone conference be conducted that evening to discuss unrelated litigation and the subject application serial No. 07/782,345.

10. A copy of a March 17, 1994 letter from David Newman to Britton Sanderford and Erin Pierce discussing the need to file a petition for revival and noting that "we ... will rely on the litigation with James D. Arthur as the basis for unavailability."

11. A copy of a September 19, 1997 letter from Michael L. Eckstein, counsel for Axonn, to the undersigned attorney of record and explaining Mr. Eckstein's recollection of his discussions with David Newman prior to abandonment of the Application Serial No. 07/782,345.

12. Deposition of David Newman given during the litigation between David Newman and Axonn.

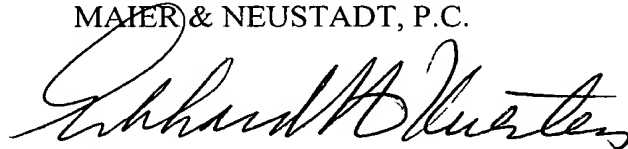
13. Deposition of Erin Pierce given during the litigation between David Newman and Axonn.

14. Deposition of Eckhard H. Kuesters given during litigation between David Newman and Axonn.

It is requested that the addition information submitted herewith be considered in the context of whether the revival of application Serial No. 07/782,345 was justified and whether Applicants complied with Rule 56 in the revival process. Copies of these papers are being filed in Serial No. 07/782,345, and also in pending application Serial No. 08/487,523 which is a continuation application and which like the present application relies on the revival of application serial No. 07/782,345 for copendency and patentability.

Respectfully submitted,

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